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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,211	12/31/2003	Paul A. Puniello	5222-114-US01	6709
79175 7590 03/17/2010 HANIFY & KING PROFESSIONAL CORPORATION 1055 Thomas Jefferson Street, NW Suite 400 WASHINGTON, DC 20007				
EXAMINER				
LEE, EDMUND H				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/748,211

**Applicant(s)**

PUNIELLO ET AL.

**Examiner**

EDMUND H. LEE

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 9-13, 15-18 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-12, 15-18 and 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/10 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 9-12, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890) and Murphy (USPN 5427378).

It should be noted that instant specification recites that a multi-color cover layer is comprised of a "first material divided into an inner layer and an outer layer by an injected intermediate layer of a second material." See pg 9, Ins 15-17 of the instant specification. The multi-color layer is made of up three layers.

In regard to claim 1, Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, Ins 1-39; figs 1-8); forming a core (col 5, Ins 1-39; figs 1-8); forming a single multi-layer over the core (col 5, Ins 1-39; figs 1-8); selecting a

material (col 5, Ins 1-39; figs 1-8); providing a first portion of the material, wherein the first portion inherently has a volume (col 5, Ins 1-39; figs 1-8); providing a second portion of the material, wherein the second portion inherently has a volume (col 5, Ins 1-39; figs 1-8); and injecting the first and second materials to form the multi-layers, wherein each injected material has an inherent volume that is a portion of the overall volume of the mold (col 5, Ins 1-39; figs 1-8). It should also be noted that the injected second volume of the second portion is inherently injected at an insertion rate (col 5, Ins 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al teaches a golf ball (col 1, Ins 38-42; fig 1); and a single multi-color cover layer, wherein the layers have different colors (col 1, Ins 38-42; fig 1)--it should be noted that together the colored inner and outer layers of Maruko et al constitute a single multi-color layer. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. Murphy teaches a golf ball including a material comprising light reflective active particles in order to produce a highly visible, reflective golf ball (abstract; col 2, Ins 38-42; col 3, Ins 4-12; col 4, In 64-col 5, In 7). Lammi (modified) and Murphy are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one

of ordinary skill in the art at the time the invention was made to include the pigment additive of Murphy into the first material of Lammi in order to form a highly visible, light reflective golf ball. In regard to claims 2-4, 9,12, such are taught by Lammi (col 5, lns 1-39; figs 1-8). In regard to claims 10 and 11, Lammi does not teach forming a substantially white first portion; and forming a substantially translucent cover over the multi-color layer. In regard to forming a substantially white first portion, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf balls having a substantially white cover layer are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the first portion of Lammi white in order to form a good appearing golf ball. In regard to forming a substantially translucent cover over the multi-color layer, such is well-known in the golf ball art in order to form a good appearing golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent cover over the multi-color layer of Lammi (modified) in order to form a good appearing golf ball. In regard to claim 22, such is well-known in the golf ball art in order to protect the performance layers. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a substantially translucent material upon the ball of Lammi (modified) in order to protect the performance layers of Lammi (modified). In regard to claim 23 and 25, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the

claimed process since it is not a manipulative feature or step of the claimed process. Further, such configuration is well-known in the golf ball art in order to provide different playing characteristics. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form first and second layers having less or equal volumes in the golf ball of Lammi in order to form a ball having different playing characteristics. In regard to claim 24, such is taught by Lammi.

4. Claims 15-17 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890) and Murphy (USPN 5427378).

It should be noted that instant specification recites that a multi-color cover layer is comprised of a "first material divided into an inner layer and an outer layer by an injected intermediate layer of a second material." See pg 9, Ins 15-17 of the instant specification. The multi-color layer is made of up three layers.

In regard to claim 15, Lammi teaches the claimed process including a method of forming a golf ball (col 5, Ins 1-39; figs 1-8); forming a core (col 5, Ins 1-39; figs 1-8); forming a single multi-layer over the core (col 5, Ins 1-39; figs 1-8); selecting a material (col 5, Ins 1-39; figs 1-8); providing a first portion of the material, wherein the first portion inherently has a volume (col 5, Ins 1-39; figs 1-8); providing a second portion of the material, wherein the second portion inherently has a volume (col 5, Ins 1-39; figs 1-8); and injecting the first and second materials to form the multi-layers, wherein each injected material has an inherent volume that is a portion of the overall volume of the

mold (col 5, lns 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al teaches a golf ball (col 1, lns 38-42; fig 1); and a single multi-color cover layer, wherein the layers have different colors (col 1, lns 38-42; fig 1)--it should be noted that together the colored inner and outer layers of Maruko et al constitute a single multi-color layer. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. Murphy teaches a golf ball including a material comprising light reflective active particles in order to produce a highly visible, reflective golf ball (abstract; col 2, lns 38-42; col 3, lns 4-12; col 4, lns 64-col 5, ln 7). Lammi (modified) and Murphy are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the pigment additive of Murphy into the first material of Lammi in order to form a highly visible, light reflective golf ball. In regard to claim 16, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf balls having a visible pigments are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to mold balls having visible pigments by the process of Lammi (modified) in order to form diverse golf balls. In regard to claim 17, such is well-known in the golf ball art in order to form a good appearing golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent cover over the multi-color layer of Lammi (modified) in order to form a good appearing golf ball. In regard to claims 26 and 27, such is taught by Lammi (col 5, lns 1-39; figs 1-8).

5. Claim 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890) and Meyer (USPN 4998734) .

It should be noted that instant specification recites that a multi-color cover layer is comprised of a "first material divided into an inner layer and an outer layer by an injected intermediate layer of a second material." See pg 9, lns 15-17 of the instant specification. The multi-color layer is made of up three layers.

Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, lns 1-39; figs 1-8); forming a core (col 5, lns 1-39; figs 1-8); forming a cover layer of multiple layers over the core (col 5, lns 1-39; figs 1-8); selecting a material (col 5, lns 1- 39; figs 1-8); providing a first portion of the material (col 5, lns 1-39; figs 1-8); providing a second portion of the material (col 5, lns 1-39; figs 1-8); and injecting the first and second materials to form the cover layer within the filled mold, wherein each injected material has an inherent volume that is a portion of the overall volume of the



mold (col 5, Ins 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive; and forming a substantially translucent cover over the multi-color cover layer. Maruko et al teaches a golf ball (col 1, Ins 38-42); and a multi-color cover layer, wherein the layers have different colors. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. In regard to forming a substantially translucent cover over the multi-color cover layer, Meyer teaches a golf ball having a translucent layer over a cover layer in order to form a shiny appearance (col 2, Ins 45-61). Lammi and Meyer are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent layer over the cover layer of Lammi (modified) as taught by Meyer in order to form a good appearing golf ball, i.e., one that has a shiny appearance. In regard to claim 28, such is taught by Lammi (col 5, Ins 1-39; figs 1-8).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571.272.1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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